

09/771,416



Attorney Docket No. 13493

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: ) Group Art Unit: 3728  
Daniel PELLERIN )  
Serial No.: 09/771,416 ) Examining Attorney: Jila M. Mohandesi  
Filed: January 26, 2001 )  
For: UNIVERSAL CLEAT )  
Pasadena, California )

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RESPONSE TO OFFICE ACTION

Honorable Commissioner of Patents  
Washington, D.C. 20231

Sir:

Claims 1-9 are in this application. All of the claims are under final rejection under 35 U.S.C. 103 as being obviousness over Tanel, Patent No. 5,058,292 in view of Kawashima et al., Patent No. 4,590,693.

These rejections are respectfully traversed.

This response is filed in a timely fashion. The six-month due date was March 9, 2003, which is a Sunday, meaning the response can be filed on March 10, 2003. The response is being filed on that date, with the appropriate certificate of mailing.

No Prima Facie Case of Obviousness Has Been Made

The present invention is directed to a universal cleat, so a single cleat can be used for the baseball shoes provided by different manufacturers.

As discussed below, Applicant has established there has been a long felt need for the invention, and this invention has achieved great commercial success. In fact, the invention has been sold for about \$300,000.

Among the features that result in the invention being successful, is the use of an oblong shaped mounting hole, which is not taught by the prior art, and the size of the cleat so that it is smaller than the area of the recess in which it fits, which is contrary to the teachings of the prior art.

Applicant does not wish to burden the record by repeating the very same arguments, submitted in response to the First Office Action. Instead, Applicant has enclosed copies of pages 5 and 6 from the prior response which Applicant believes clearly establishes why a prima facie case of obviousness has not been made.

In addition, Applicant wishes to respond to particular comments made in the final rejection.

With regard to claims 2 and 5, the Office Action states “the universal cleat will inherently wiggle in the recess in the absence of the retaining fastener.” That is true, but only because the present invention requires it. This is contrary to the teachings of the art. The Examiner’s attention is directed to the background portion of the application which states in the last paragraph on page 1:

“Attempts to carry just one type of cleat from one manufacturer have been unsuccessful because the cleats from one manufacturer generally do not fit into the recesses and the soles of the baseball shoe of another manufacturer. One reason for this is the belief that the cleats must snugly fit into the recess so there is no wiggle, with the cleats retained firmly in place, even without the retaining screw.” (emphasis added)

Thus, the wiggle found in Applicant's product is not taught nor suggested by the prior art. The Examiner is right in that it will inherently wiggle, but only because that is part of Applicant's invention. This is completely contrary to the teachings of the prior art.

Moreover, as previously noted, as representative of the prior art, Kawashima et al., teaches that the base of his spikes needs to be in "close engagement" to keep soil out.

Claims 8 and 9 further refine this concept specifying how much smaller the area of the base is relative to the recess. Contrary to the examiner's assertion, this has nothing to do with the type and size of shoes being used. This is to provide wiggle room.

It appears that in the Office Action the Patent Office is applying the "common sense" of one of ordinary skill in the art. This was rejected by the Federal Circuit in In re Lee, 277 F.3d 1338, 61 USPQ 2d 1430 (Fed. Cir. 2002). The Federal Circuit made it clear that such reliance is improper, and a reference supporting the so-called "common sense" or "common knowledge" is required. No such reference has been cited.

It is suggested in the Office Action that the ratio of the length of the mounting hole to the width of the mounting hole is a mere matter of design choice, as these are specified in claims 3 and 6. There is no support for this suggestion. As made clear from the specification, the ratios were chosen to provide a universal cleat. The prior art does not suggest such a ratio. As stated in the specification, this is beyond a mere design choice:

"If the ratio is too small, not enough different types of baseball shoes can be accommodated; if the ratio is too large; the structure of the cleat is unduly weakened." (page 4, lines 18-20)

Where does the prior art suggest these ratios and these competing factors?

Moreover, what is stated in the Office Action, makes absolutely no sense. What is said "the ratio of the length of the mounting hole to the width of the mounting hole would be a design choice depending on the shape and size of the mounting hole." (emphasis added) This is irrational. Of course, the statement is true, but it has no relationship to the patentability of the invention. It is a mere tautological statement. It is akin to saying that the wing span of a

bird is dependent upon the size of the wing. Of course it is, but that has nothing to do with the ability of birds to fly.

Secondary Considerations Establish The Non-Obviousness of The LAI MED Invention

The Federal Circuit has made clear, commercial success must be considered before a conclusion on obviousness is reached. DeMaco v. F. Von Langsdorff Lic., Ltd., 851 F.2d 1387, 7 USPQ 2d 1222 (Fed. Cir. 1988); Lindemann Maschinenfabrik v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

There has been commercial success, as established by the following declarations:

1. Stephen Libonati (President of the original owner of the invention);
2. Jon Reichlin (President of the current owner of the invention);
3. Dan Floyd (buyer for retailer Hibbett Sports);
4. Buyer for Reda Sports;
5. Buyer for Sportshoe Center;
6. Buyer for Modellis Sporting Goods; and
7. Buyer from Big 5

Also accompanying the declarations is a sample of the product that is referred to in the declarations as "ProArc" so there is no question that the product that has been commercially successful is within the scope of the claims of the present applications.

These declarations establish:

1. There was a long felt need for the product. Four the declarants state: "I carry this product because there has been a long time need for the product."
2. The product achieved commercial success. According to Stephen Libonati:  
"The product was very successful in the marketplace. It achieved sales of about \$275,000 in the first year and over \$300,000 in the second year the product was on the market. These sales reflect the direct replacement of cleats sold by the shoe manufacturers."

3. The invention has been sold for about \$300,000 which is also evidence of the commercial success. See Declaration of Jon Reichlin. The explanation for this success can be found in the Declaration of John Reichlin, which states:

“In hindsight, like most innovations in our field, the invention may appear simple, but it really is not. It was a very clever idea to figure out how to accommodate so many different types of cleated footwear.”

4. Further evidence of the commercial success is the identity of major sporting good retailers carrying the product, such as Sports Authority, Big 5, Garts Sport, Modell Sporting Goods, Dick’s Sporting Goods, and Academy Sports. (Reichlin Decl., ¶ 4).

5. A most compelling fact is that the present owner of the invention, Shoe Shoe Supplies, Inc., was willing to pay \$300,000 for this invention, even though this present utility application is under final rejection. This speaks well about the buyer’s belief in the merits of the invention.

In view of this commercial success, and in view of the declarations submitted by those actually in the marketplace, it is respectfully submitted that the Patent Office is second guessing the real world. In hindsight, the Patent Office is finding the invention obvious. However, those in the know, the buyers in the marketplace, and a manufacturer of related products, have stated otherwise.

As stated by the Federal Circuit:

“Evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decisionmaker remains in doubt after reviewing the art.

The rationale for giving weight to the so-called 'secondary considerations' is that they provide objective evidence of how the patented device is viewed in the marketplace, by those directly interested in the product."

See Demaco, supra, 77 USPQ 2d at 1225.

### CONCLUSION

For the foregoing reasons, it is respectfully submitted that the present application is in condition for allowance. Such allowance is respectfully requested.

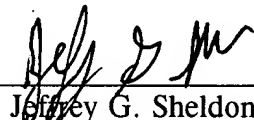
Please note that a Conditional Notice of Appeal is submitted herewith. If this present response does not place this application in condition for allowance, entry of the Notice of Appeal is respectfully requested.

If there are any remaining issues that the Examiner believes can be resolved by telephone conference, it is respectfully requested that a telephone call be placed to the undersigned. It is our experience that such telephone interviews often lead to early disposal of applications.

Respectfully submitted,

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